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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/549,988

04/14/2000

Jeffrey M. Chasen

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06/04/2002

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EXAMINER

BOCCIO, VINCENT F

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 06/04/2002

*819*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/549,988**

Applicant(s)  
**Chasen**

Examiner  
**Vincent F. Boccio**

Art Unit  
**2615**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on May 24, 2002

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-24, 27, and 28 is/are pending in the applica

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from considera

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-24, 27, and 28 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirem

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

4) ☒ Interview Summary (PTO-413) Paper No(s). 8

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 & 6

6) ☐ Other:

**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2615.

**Election/Restriction**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-24, drawn to "an apparatus and method for simultaneous recording data, while reproducing previously recorded data", best searched and classified in class 386, subclass 68.
  - II. Claims 25-26, drawn to "a method of testing a recording, reproduction device, such as a CD Rom drive", best searched and classified in class 714, subclass 719 etc...
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions Group I and Group II are related as sub-combinations disclosed as usable together in a single combination.

The subcombinations are distinct from each other if they are shown to be separately usable.

In the instant case, inventions I & II, have separate utility by being usable, "alone or independently".

Group I has separate utility such as performing simultaneous recording and reproduction.

Group II has separate utility such as testing a recording and reproduction device, such as a CD Rom drive, the testing being associated with recording and reproduction of data associated with speed, without errors, or without exceeding an error threshold.

See MPEP § 806.05(d).

During a telephone conversation with Arthur Rose #28,038 on 5/21/02 a provisional election was made without traverse to prosecute the invention of I, claims 1-24 and newly presented claims 27-28 in a pre-amendment on 5/24/02, directed toward the same group elected.

Affirmation of this election has been made by applicant in replying to the request for restriction.

Claims 25-26 have been withdrawn and canceled in the pre-amendment therefore, removed from further consideration by the examiner/applicant in this application, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in--

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-11, 13-14, 19-24 and 27 are rejected under 35

U.S.C. 102(e) as being anticipated by Thomason et al. (US 6,018,612).

Regarding claims 1-2, 6-7, 13 and 19-24, Thomason in Fig. 1, meets the limitations associated with a method and associated apparatus for recording and playing data, the apparatus and associated method comprising the steps performed on the elements as recited comprising:

- o a first and second devices (col. 4, line 35-, hard disk 36 and buffer memory 35);
- o a record and play modules ("elements 33 and 12-14" & "elements 2-4, 31") which are configured to record on the second device, a first stream representing a first set of data from the

first device; and also configured to play a second stream representing a second set of data

from the second device wherein the play module plays the second stream while the record module records the first stream.

The system is configured to receive TV signals thru tuner 1, , therefore video and audio, wherein data is received by element 2, from the tuner and stored, while earlier data received and stored data, can be controlled by user interface 26, reproduced and output at element 12.

Regarding claims 3-5 and 9-11, Thomason all meets the limitations of audio, video or multimedia, since TV signals are received with audio and video.

Regarding claim 14, Thomason all meets the limitations wherein the first and seconds devices, could be the same device box, or element, first-second devices (met by the combination of 35 and 36, as like the record and play modules, may comprise multiple elements inside the unit or device).

Regarding claim 27, since Thomason discloses the microprocessor controlled, with programming in the Rom 22 and parameters or variables in RAM 23, as disclosed col 3., "software", etc., the limitation as recited computer readable medium comprising instruction for performing the simultaneous recording of data and the reproduction of data from the system is considered met in view thereof.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 12, 16-18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason et al. (US 6,018,612).

Regarding claim 12, Thomason meets the limitation of a first device, and discloses the utilization of a hard disk, but fails to disclose the utilization of a CD ROM type <sup>drive</sup> ~~media~~. VPS

The examiner takes official notice that CD ROM type recording devices are well known and widely used and available type devices, therefore, it would have been obvious to one skilled in the art at the time of the invention to Thomason by substituting a CD ROM type device, the substitution being considered an obvious design choice to choose between widely used and available recording devices, to perform the same as the hard disk used by Thomason.

Regarding claims 16-18, Thomason as applied above meets all limitations as recited but fails to disclose encryption of the input data such as audio encryption of received audio data.

The examiner takes official notice, that audio encryption is well known and obvious technique to protect audio material, therefore, it would have been obvious to one skilled in the art

at the time of the invention to modify Thomason as applied by incorporating encryption of input audio in order to protect audio works as is well known.

Regarding claim 28, Thomason as applied discloses receiving TV signals, which have audio and video, but, fails to disclose wherein the data is in a packet or packetized form from a remotely disclosed computer network.

The examiner takes official notice that receiving data signals in packet form is well known over the Internet etc., therefore, it would have been obvious to one skilled in the art at the time of the invention to utilize or even substitute a source from the Internet to receive data in packets, being a mere design choice of a source well known and obvious to one skilled in the art.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason et al. (US 6,018,612) in view of Toshinori (EP 07249271, dated 9/1995).

Regarding claim 15, Thomason fails to disclose performing tests on the CD ROM or the first device.

Toshinori teaches a system for performing a record test on a CD rom device, to evaluate the CD rom drive, as taught by Toshinori.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Thomason by

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incorporating at least one test to evaluate the CD Rom device or disk memory device used, as taught by Toshinori.

Contact Fax Information

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


Contact Information

9. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vin  
June 1, 2002

  
VINCENT BOCCIO  
PRIMARY EXAMINER